

**REMARKS**

Applicants reply to the Office Action mailed on July 8, 2005, within the shortened statutory three-month period for reply. Applicants add new claims 13-17. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments.

**DOUBLE PATENTING**

The Examiner provisionally rejects claims 1-12 over claims 1-4, 6, and 8-12 of co-pending Application Serial No. 10/708,838 (U.S. Patent Application No. 2004/0233039). While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this non-statutory double patenting rejection is based on the above-listed application, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

**35 U.S.C. § 103 REJECTIONS*****Rejections Under 35 U.S.C. § 103(a)—the Black Reference***

The Examiner rejects claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Black, U.S. Patent Application No. 2005/0122209 ("Black"). The Examiner notes that, "Re claim 1, Black teaches contacting an authorized sample receiver...proffering a biometric to a biometric sensor such that the sensor obtains a biometric sample...user information and transponder information to the system to facilitate the system associating the biometric sample with user information and transponder information to create a data packet." (page 7). Applicants respectfully transverse this rejection.

In general, Black discloses an identity authentication system comprising a device for capturing a customer signature. Black requires a user to provide an electronic signature using a stylus or other similar device ([0016], [0022]). Further, while Black discloses submitting personal data during the registration procedure (Fig. 5A), Black only discloses such personal data to be customer record numbers, customer bank, account numbers, account balance, reference prints and reference signatures (Fig. 10A-B, 11A-B). Black is silent as to providing transponder information as noted by the Examiner (page 7-8), not because such information is

obviously provided, but because Black does not enable both biometric registration and wireless payment. Rather, Black merely provides access to a payment account "when the sensed digital signature matches a reference digital signature" ([0020]).

Further still, Black is limited to associating a single transaction account with the customer record/transponder (Figs. 10A-B, 11A-B, [0087]). That is, Black is limited to having a transponder "linked with a credit or debit account" only ([0089]), and not with multiple credit and/or debit accounts. Thus, Black does not teach or disclose at least "associating said proffered biometric sample with said user information and said transponder information to create a data packet, wherein said proffered biometric sample is associated with at least two of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent claim 1.

Claims 2-6 depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that claims 2-6 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-6.

***Rejections Under 35 U.S.C. § 103(a)—the Black and Maritzen References***

The Examiner rejects claims 7 and 9-12 as being unpatentable over Black, as discussed above, in view of Maritzen, et al., U.S. Patent Application No. 2002/0191816 ("Martizen"). Applicants respectfully traverse.

Neither Black, Maritzen, nor any combination thereof, teach or disclose at least "associating said proffered biometric sample with said user information and said transponder information to create a data packet, wherein said proffered biometric sample is associated with at least two of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent claim 1. Moreover, claims 7 and 9-12 indirectly and directly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 7 and 9-12 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 7 and 9-12.

***Rejections Under 35 U.S.C. § 103(a)—the Black and Moebs References***

The Examiner rejects claim 8 as being unpatentable over Black, as discussed above, in view of Moebs et al, U.S. Patent Application No. 2005/0065872 ("Moebs"). Applicants respectfully traverse this rejection.

Neither Black, Moebs, nor any combination thereof, teach or disclose at least "associating said proffered biometric sample with said user information and said transponder information to create a data packet, wherein said proffered biometric sample is associated with at least two of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent claim 1. Moreover, claim 8 directly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 8 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 8.

***Rejections Under 35 U.S.C. § 103(a)—the Black, Martizen and Iannacci References***

The Examiner rejects claim 8 as being unpatentable over Black/Martizen et al., in view of Iannacci, U.S. Patent Application No. 2002/0062249 ("Iannacci"). Applicants respectfully traverse this rejection.

Neither Black, Martizen, Iannacci, nor any combination thereof, teach or disclose at least "associating said proffered biometric sample with said user information and said transponder information to create a data packet, wherein said proffered biometric sample is associated with at least two of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent claim 1. Moreover, claim 8 directly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 8 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 8.

**NEW CLAIMS 13-17**

New claims 13-17 depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that new claims 13-17 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

**CONCLUSION**

Applicants respectfully submit that the pending claims are in condition for allowance. Reconsideration of the application is thus requested. **The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814.** Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

Dated: August 25, 2005

By: 

Emma Harty  
Reg. No. 56,677

**SNELL & WILMER LLP.**  
400 East Van Buren  
One Arizona Center  
Phoenix, Arizona 85004-2202  
Tel: (602) 382-6347  
Fax: (602) 382-6070  
Email: [eharty@swlaw.com](mailto:eharty@swlaw.com)